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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,519	11/28/2000	John S. Hendricks	026880.00017	6858

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EXAMINER

CHAI, LONGBIT

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/722,519	Applicant(s) HENDRICKS, JOHN S.	
	Examiner Longbit Chai	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Original application contained claims 1 – 26 and claims 14 and 26 have been canceled. Claim 21 has been amended in an amendment filed on 2/22/2006. The amendment filed have been entered and made of record. Presently, pending claims are 1 – 13 and 15 – 25.

Response to Arguments

1. Applicant's arguments with respect to the subject matter of the instant claims have been fully considered but are not persuasive.

2. As per claim 21 (& claim 12), Applicant asserts: "the primary reference of Hartrick was filed as U.S. application no. 546,334 on June 29, 1990, and patented on June 27, 1995. However, the secondary reference of Choudhury was filed as U.S. application no. 187,580 on January 27, 1994, and patented on April 16, 1996. Given that the effective filing dates of the present application are December 9, 1992, and December 2, 1993, the subject matter of the present application predates the effective filing date of Choudhury. As such, it is respectfully submitted that Choudhury is NOT a valid reference with respect to this rejection". Examiner disagrees because the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph

of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 08/160,194 and 07/991,074, fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application and as such the effective filing date for the subject matter defined in the pending claims in this application is 11/07/1994.

3. As per claim 13, Applicant asserts: "MacPhail fails to teach the packet has a unique packet identifier, determining whether the packet identifier matches a library identifier of the library; and if the packet identifier matches the library identifier, storing the packet to a data file in a library storage". Applicant's arguments have been fully considered but are not persuasive. This is because MacPhail teaches electronic document can be realized from a network which connects office systems in various locations in the organization as well as using Document Interchange Architecture protocols that enable programs to interchange information such as documents and messages (MacPhail: Column 1 Line 38 – 49 and Column 4 Line 27 – 31) and therefore, the method must include transmitting / receiving a packet of text data over a network (MacPhail: see for example, Column 1 Line 38 – 49, Column 4 Line 27 – 31 and Column 4 Line 58 – 61: MacPhail discloses the benefits of electronic document processing can be realized from a network between a viewer and a library server); (b) determining whether the packet has a unique packet identifier (MacPhail: see for example, Column 1 Line 38 – 42, Column 4 Line 26 – 31 and Column 2 Line 61 – 63:

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Examiner notes each packet of the network must have a unique ID in order to transmit the indicated documents to the identified recipient end user such that the relationship of documents is maintained (Column 2 Line 61 – 63)); (c) if the packet has a unique packet identifier, determining whether the packet identifier matches a library identifier of a library; and if the packet identifier matches the library identifier, storing the packet to a data file in a library storage (MacPhail: see for example, Column 4 Line 40 – 43: the library server performs various services such as for storing and retrieving documents electronically (Column 4 Line 41 – 42) and thereby Examiner notes the packet identifier must match the library identifier in order to assure the correct destination of electronic document delivery).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1 – 11 and 21 – 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Choudhury (Patent Number: 5509074).

As per claim 1, Choudhury teaches a method of communicating between components of a home subsystem comprising a library and a viewer for processing electronic books, the method comprising:

In the library, comparing a unique key associated with data text of an electronic book to a corresponding unique key of the viewer (Choudhury: see for example, Column 4 Line 13 – 18, Column 2 Line 57 – 60 and Column 2 Line 65 – 67: the library is interpreted as the collection of document server and copyright server. The unique key is interpreted as the unique identification presented by the user when making a request for a document via network such as a credit card number, or other relatively valuable number that a user would not be willing to give away to someone else for illicit purposes, as taught by Choudhury, and thereby it is qualified as a unique security key of the viewer or the user).

If the comparing step produces a match, sending the data text related to an electronic book from the library to the viewer (Choudhury: see for example, Column 2 Line 58 – 60 and Column 2 Line 65 – 67);

storing the data text in the viewer (Choudhury: see for example, Column 2 Line 65 – 67: the user computer must have a memory to store the data text for further operation).

As per claim 2, Choudhury teaches the claimed invention as described above (see claim 1). Choudhury teaches encrypting the data text (Choudhury: see for example, Column 2 Line 62 – 64).

As per claim 3 and 6, Choudhury teaches the claimed invention as described above (see claim 2 and 5 respectively). Choudhury further teaches preventing the viewer from outputting decrypted data text (Choudhury: see for example, Column 3 Line 10 – 11 and Column 4 Line 31 – 32).

As per claim 4 and 7, Choudhury teaches the claimed invention as described above (see claim 2 and 5 respectively). Choudhury further teaches displaying the data text on a display portion of the viewer; and decrypting the data text as the data text is displayed (Choudhury: see for example, Column 3 Line 44 – 45 and Column 4 Line 25 – 31: Choudhury teaches once the displayer receives the encrypted document, the device decrypts it and displays it (Column 4 Line 25 – 26). Examiner notes the device (either screen displayer or printer) must use microprogram memory buffer (or memory page) to perform the functions of decrypting and displaying electronic documents and accommodate the screen display buffer / page one at a time).

As per claim 5, Choudhury teaches the claimed invention as described above (see claim 1). Choudhury teaches preventing the viewer from outputting decompressed data text (Choudhury: see for example, Column 6 Line 15 – 17).

As per claim 8, Choudhury teaches the claimed invention as described above (see claim 1). Choudhury teaches the data text is encrypted and compressed when it

is received by the viewer, and further comprising decompressing and decrypting a portion of the data text (Choudhury: see for example, Column 6 Line 15 – 17).

As per claim 9, Choudhury teaches the claimed invention as described above (see claim 1). Choudhury teaches encrypting and compressing the data text before it is sent to the viewer, and further comprising decompressing and decrypting the data text one page at a time, as a current page is displayed on the viewer (Choudhury: see for example, Column 3 Line 44 – 45 and Column 4 Line 25 – 31: Choudhury teaches once the displayer receives the encrypted document, the device decrypts it and displays it (Column 4 Line 25 – 26). Examiner notes the device (either screen displayer or printer) must use microprogram memory buffer (or memory page) to perform the functions of decrypting and displaying electronic documents and accommodate the screen display buffer / page one at a time).

As per claim 10, Choudhury teaches the claimed invention as described above (see claim 1). Choudhury teaches the viewer has a unique key for decrypting the data text, whereby only one viewer can access a particular transmission of data text (Choudhury: see for example, Column 1 Line 46 – 61).

As per claim 11, Choudhury teaches the claimed invention as described above (see claim 1). Choudhury further teaches the data text is transmitted as a digital bit stream (Choudhury: see for example, Column 2 Line 2 Line 58).

As per claim 21, Choudhury teaches a method for processing data text for electronic books comprising:

sending a packet of data text from a remote operations center to the library (Choudhury: see for example, Column 1 Line 37 and Figure 1 Element 3 discloses the electronic document networking techniques. Copyright Server and Document Server are qualified to serve as the remote operations center and the document library respectively. The user is qualified as a viewer. The necessity of networking techniques, shown in Figure 1, depends upon the close physical proximity between the source and destination entities);

encrypting and compressing the packet (Choudhury: see for example, Column 1 Line 43 – 61);

sending the packet to a viewer communicatively coupled to the library (Choudhury: see for example, Column 1 Line 43 – 61);

storing the packet in a viewer storage (Choudhury: see for example, Column 1 Line 43 – 61);

decompressing and decrypting the packet, comprising decompressing and decrypting an electronic book by page, just before a page is displayed on the display of the viewer (Choudhury: see for example, Column 3 Line 44 – 45 and Column 4 Line 25 – 31: Choudhury teaches once the displayer receives the encrypted document, the device decrypts it and displays it (Column 4 Line 25 – 26). Examiner notes the device (either screen displayer or printer) must use microprogram memory buffer (or memory

page) to perform the functions of decrypting and displaying electronic documents and accommodate the screen display buffer / page one at a time);

displaying the data text on a display of the viewer (Choudhury: see for example, Column 3 Line 44 – 45 and Column 4 Line 25 – 31).

As per claim 22, Choudhury teaches the claimed invention as described above (see claim 21). Choudhury further teaches storing the packet to a data file in the library, which data file is capable of storing a plurality of packets related to an electronic book (Choudhury: see for example, Column 1 Line 43 – 61).

As per claim 23, Choudhury teaches the claimed invention as described above (see claim 22). Choudhury further teaches the step of encrypting and compressing the packet comprises encrypting and compressing the data file, and wherein the step of sending the packet to the viewer comprises sending the data file to the viewer (Choudhury: see for example, Column 1 Line 43 – 61).

As per claim 24, Choudhury teaches the claimed invention as described above (see claim 21). Choudhury further teaches the data packet is sent in a bit stream having a packet identifier, and further comprising comparing a packet identifier with a library identifier, and wherein the step of sending the packet to the library comprises sending the packet to the library if the packet identifier matches the library identifier (Choudhury: see for example, Column 1 Line 43 – 61).

As per claim 25, Choudhury teaches the claimed invention as described above (see claim 24). Choudhury further teaches the step of decompressing and decrypting the data file comprises using a security key unique to the viewer (Choudhury: see for example, Column 1 Line 46).

2. Claims 13, 14 and 17 – 20 are rejected under 35 U.S.C. 102(b) as being anticipated by MacPhail (Patent Number: 5089956).

As per claim 13, MacPhail teaches a method for processing text data for an electronic book comprising:

receiving a packet of text data (MacPhail: see for example, Column 1 Line 38 – 49 and Column 4 Line 27 – 31: MacPhail discloses the benefits of electronic document processing can be realized from a network between a viewer and a library server);

determining whether the packet has a unique packet identifier (MacPhail: see for example, Column 1 Line 38 – 42, Column 4 Line 26 – 31 and Column 2 Line 61 – 63: each packet of the network must have a unique ID in order to transmit the indicated documents to the identified recipient end user such that the relationship of documents is maintained (Column 2 Line 61 – 63));

if the packet has a unique packet identifier, determining whether the packet identifier matches a library identifier of a library; and if the packet identifier matches the library identifier, storing the packet to a data file in a library storage (MacPhail: see for example, Column 4 Line 40 – 43: the server library performs various services such as

for storing and retrieving documents electronically (Column 4 Line 41 – 42) and thereby the packet identifier must match the library identifier to assure the correct destination of electronic document delivery).

As per claim 14, MacPhail teaches the claimed invention as described above (see claim 13). MacPhail further teaches the packet is received by the library (MacPhail: see for example, Column 4 Line 58 – 64, Column 2, 60 – 64, and Column 1 Line 38 – 49).

As per claim 17, MacPhail teaches the claimed invention as described above (see claim 13). MacPhail further teaches the step of storing comprises:

determining whether the data file has been opened (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be opened before the data can be stored from the packet) , and

if the data file has been not been opened, opening the data file; and storing the packet to the data file (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be opened before the data can be stored from the packet).

As per claim 18, MacPhail teaches the claimed invention as described above (see claim 17). MacPhail further teaches:

determining whether the packet is a final packet received for an electronic book (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and

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Column 1 Line 61 – 65: The data file must be closed after the data written has been completed),

if the packet is the final packet, closing the data file; and updating a directory (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be closed after the data written has been completed).

As per claim 19, MacPhail teaches the claimed invention as described above (see claim 13). MacPhail further teaches sending the data file to a viewer (MacPhail: see for example, Column 2 Line 60 – 64).

As per claim 20, MacPhail teaches the claimed invention as described above (see claim 19). MacPhail further teaches encrypting and compressing the data file (MacPhail: see for example, Column 6 Line 15 – 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Choudhury (Patent Number: 5509074), in view of Boulton (Patent Number: 4985697).

As per claim 12, Choudhury teaches the claimed invention as described above (see claim 1). Choudhury does not teach the data text is transmitted from a remote cable headend to the library and bundled into a data file, which data file is sent to the viewer.

Boulton teaches the data text is transmitted from a remote cable headend to the library and bundled into a data file, which data file is sent to the viewer (Boulton: see for example, Column 10 Line 63 – 65).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Boulton within the system of Choudhury because Boulton teaches a cable TV transmission technique for electronic book applications.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (Patent Number: 5089956), in view of Boulton (Patent Number: 4985697).

As per claim 15, MacPhail teaches the claimed invention as described above (see claim 14). MacPhail does not teach the packet is transmitted as a digital bit stream from a remote cable headend to the library.

Boulton teaches the packet is transmitted as a digital bit stream from a remote cable headend to the library (Boulton: see for example, Column 10 Line 63 – 65).

Same rationale of combination applies here as above in rejecting the claim 12.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (Patent Number: 5089956), in view of Feigenbaum (Patent Number: 4644470).

As per claim 16, MacPhail teaches the claimed invention as described above (see claim 13). MacPhail does not teach if the packet does not have a unique packet identifier, storing the packet to an electronic message file.

Feigenbaum teaches if the packet does not have a unique packet identifier, storing the packet to an electronic message file (Feigenbaum: see for example, Column 4 Line 45).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Feigenbaum within the system of MacPhail because Feigenbaum teaches a method of allowing data processing systems to adopt names on either a unique or non-unique basis, which would in effect be transparent to the user if it is a non-unique name for broadcast messages (Feigenbaum: see for example, Column 2 Line 21 – 24 and Column 2 Line 13 – 15).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LBC

Longbit Chai
Examiner
Art Unit 2131

CHRISTOPHER REVAK
PRIMARY EXAMINER


3/17/06